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09/711,049	11/09/2000	Masahito Niikawa	15162/02720	6084

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EXAMINER
DAMIANO, ANNE L

ART UNIT	PAPER NUMBER
2184	6

DATE MAILED: 07/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>09 November 2000</u> .

2a)☐ This action is **FINAL**.　　2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-40</u> is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-11,14,15,18,20-32 and 34-40</u> is/are rejected.

7)☒ Claim(s) <u>12,13,16,17,19 and 33</u> is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>09 November 2000</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All　b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)　　　　　　　4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)　5) ☐ Notice of Informal Patent Application (PTO-152)

3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>2 and 4</u> .　6) ☐ Other: .

DETAILED ACTION

EXAMINER'S AMENDMENT

1.   The application has been amended as follows:

Claim 15, line 6, insert --where-- following "state".

Allowable Subject Matter

2.   Claims 12, 13, 16, 17, 19 and 33 are objected to as being dependent upon a rejected base

claim, but would be allowable if rewritten in independent form including all of the limitations of

the base claim and any intervening claims.

Specification

3.   The lengthy specification has not been checked to the extent necessary to determine the

presence of all possible minor errors. Applicant's cooperation is requested in correcting any

errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on
sale in this country, more than one year prior to the date of application for patent in the United States.

4.   Claims 25, 36, 39 and 40 are rejected under 35 U.S.C. 102 (b) as being anticipated by

Fawcett et al. (5,678,002).

As in claim 25 and 39, Fawcett discloses a method (and computer-readable medium

carrying a program to perform the method (claim 15)) of serving an inspection program for an

electronic device which belongs to a customer through computer communication (column 3:

lines 18-20), the method comprising the steps of:

a) registering a plurality of inspection programs (diagnostic agent) on a server, the

plurality of inspection programs corresponding to a plurality of functions of the electronic

device, respectively;

b) accepting selection of an inspection program out of the plurality of inspection

programs from the customer; and

c) accepting download of the inspection program selected in step b) (column 2: lines 5-

10, column 6: lines 35-45, column 7: lines 36-40 and column 8: lines 5-9 and 14-18). (The

relevant diagnostic agent in interpreted as corresponding to the functions of the electronic

devices. The execution of a diagnostic agent (column 8: lines 5- 9 and 14-18) is the accepting

selection of an inspection program out of the plurality of inspection programs.)

As in claim 36, Fawcett discloses an apparatus for serving an inspection program for an

electronic device through computer communication (column 3: lines 18-20), the electronic

device belonging to a customer, the apparatus comprising:

a receiving circuit for receiving messages from the customer (column 4: lines 52-59)

(Some receiving mechanism, equivalent to a circuit must exist in the system in order for

messages to be received.); and

a processor for registering a plurality of inspection programs (diagnostic agent)

corresponding to a plurality of functions of the electronic device, respectively, accepting

selection of an inspection program out of the plurality of inspection programs, and accepting

download of the inspection program selected by the customer (column 2: lines 5-10, column 6: lines 35-45, column 7: lines 36-40 and column 8: lines 5-9 and 14-18). (The relevant diagnostic agent in interpreted as corresponding to the functions of the electronic devices. The execution of a diagnostic agent (column 8: lines 5- 9 and 14-18) is the accepting selection of an inspection program out of the plurality of inspection programs.)

As in claim 40, Fawcett discloses the computer readable-medium being a hard disk system connected to a server on a computer network (column 2: lines 52-61). (It is interpreted that all of the data dictating the process of claim 39, is stored on the memory of the computer system.)

5.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the

reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA

35 U.S.C. 102(e)).

6.   Claims 1-4, 7-11, 14, 15, 18, 20-24, 26-32, 34, 35 and 37-38 are rejected under 35

U.S.C. 102(e) as being anticipated by Iglehart et al. (5,903,626).

        As in claim 1, Iglehart discloses a method of diagnosing an electronic device (digital

feature phones), which belongs to a customer, comprising the steps of:

        a) receiving an inspection result (results of troubleshooting) obtained by executing an

inspection program (troubleshooting functions) on the electronic device on the customer's side;

and

        b) obtaining a diagnosis result (performance characteristics) by diagnosing said electronic

device on the basis of the inspection result (column 2: lines 3-19, column 3: lines 45-55, column

4: line 59-64).

        As in claim 2, Iglehart discloses the method further comprising the step of supplying the

inspection program to said customer before step a) (column 4: lines 14-21). (Instructing the

troubleshooting program to carry out specified troubleshooting operations in the digital phone is

interpreted as supplying the inspection program to the customer.)

        As in claim 3, Iglehart discloses the method further comprising the step of

        c) sending a computer-readable medium carrying the inspection program to the customer,

wherein

step c) is performed before step a) (column 2: lines 9-12 and column 4: lines 14-21).

(Instructing the troubleshooting program to carry out specified troubleshooting operations in the

digital phone is interpreted as an inspection program. Transmitting signals that specify the

inspection program is interpreted as computer-readable medium carrying the inspection

program.)

As in claim 4, Iglehart discloses the method further comprising the step of

d) sending the inspection program to the customer through computer communication,

wherein

step d) is performed before step a) (column 2: lines 9-12 and column 4: lines 14-21).

(Instructing the troubleshooting program to carry out specified troubleshooting operations in the

digital phone is interpreted as an inspection program.)

As in claim 7, Iglehart discloses

A computer-readable medium carrying the inspection result being received in step a)

(column 1: lines 13-18). (The transmitting signals that contain the results of the inspection

program are interpreted as computer-readable medium carrying the inspection result being

received.)

As in claim 8, Iglehart discloses

The inspection result being received through computer communication in step a) (column

1: lines 13-18).

As in claim 9, Iglehart discloses

Step a) including the step of confirming whether data received as an inspection result is a

valid inspection result or not (column 4: line 59-column 5: line 2). (A second round of

troubleshooting being necessary is interpreted as the inspection result not being valid, since this

result will cause further troubleshooting.)

As in claim 10, Iglehart discloses the method further comprising the step of

e) transmitting the diagnosis result to the customer (column 5: lines 4-6). (Repairs being

performed imply the diagnostic result was transmitted to the customer.)

As in claim 11, Iglehart discloses the method further comprising the step of

f) accepting a request of repair from the customer through computer communication

(column 3: lines 4-16) (Since the repair is automatically performed, if needed, the initial

malfunction cause the troubleshooting to occur, is interpreted as being the request of repair from

the customer.)

As in claim 14, Iglehart discloses the method further comprising,

the diagnostic result including information which indicates whether the electronic device

needs repair or not (column 5: lines 4-6). ("…necessary repairs, if any…" implies that some sort

of indication is included in the diagnosis result to distinguish between devices needing repair and

devices not needing repair.)

As in claim 15, Iglehart discloses the method further comprising,

The diagnostic result (performance characteristics) including information which indicates

a state selected from the group comprising:

A first state where the electronic device is normal;

A second state where the electronic device has trouble but needs no repair; and

A third state where the electronic device needs repair (column 2: lines 16-19 and column

5: lines 4-12). (Since the system diagnostic checkups on phones for which no malfunctions have

been reported, it is interpreted that normal state is included in the performance characteristics of

the phone. Also, since "…necessary repairs, if any…" implies that some sort of indication is

included in the diagnosis result to distinguish between malfunctioning devices needing repair and

malfunctioning devices not needing repair. Therefore, it is interpreted that the diagnostic results

include state information comprising normal, trouble but needs no repair and needs repair states.)

As in claim 18, Iglehart discloses

Step b) being performed by a computer (column 5: line 56-64).

As in claim 20, Iglehart discloses a method of diagnosing an electronic device which

belongs to a customer comprising the steps of:

a) receiving an inspection result (results of troubleshooting) carried in a computer

readable medium, the inspection result obtained by executing an inspection program on the

electronic device on the customer's side; and

b) reading out the inspection result from the computer-readable medium (column 2: lines 3-19, column 3: lines 6-12, lines 45-55, column 4: line 59-64). (Sending signals that contain the results of the inspection program is interpreted as receiving a computer-readable medium carrying the inspection result. In order for the diagnostic device to determine the performance characteristics of the phones, it must read the inspection result from the computer-readable medium.)

As in claim 21, Iglehart discloses the method further comprising the step of

c) sending a computer-readable medium carrying the inspection program to the customer, wherein

step c) is performed before step a) (column 2: lines 9-12 and column 4: lines 14-21). (Instructing the troubleshooting program to carry out specified troubleshooting operations in the digital phone is interpreted as an inspection program. Transmitting signals that specify the inspection program is interpreted as computer-readable medium carrying the inspection program.)

As in claim 22, Iglehart discloses a method of diagnosing an electronic device which belongs to a customer comprising the steps of:

a) receiving an inspection result (results of troubleshooting) through computer communication, the inspection result obtained by executing an inspection program on the electronic device on the customer's side; and

b) preparing for reading out the inspection result (column 2: lines 3-19, column 3: lines 6-12, lines 45-55, column 4: line 59-64). (The communication between the electronic device and the diagnostic device is computer communication. In order for the diagnostic device to determine the performance characteristics of the phones, it must read the inspection result.)

As in claim 23, Iglehart discloses the method further comprising the step of

c) sending the inspection program to the customer through computer communication, wherein

step c) is performed before step a) (column 2: lines 9-12 and column 4: lines 14-21). (Instructing the troubleshooting program to carry out specified troubleshooting operations in the digital phone is interpreted as an inspection program.)

As in claim 24, Iglehart discloses the method further comprising the step of

d) accepting selection of an inspection program out of a plurality of inspection programs from the customer; wherein

step d) is performed before step c) (column 3: lines 4-20).

As in claim 26, Iglehart discloses a method of serving an inspection program for an electronic device which belongs to a customer, the method comprising the steps of:

a) preparing an inspection program (troubleshooting functions) (column 3: lines 4-20) (Since the troubleshooting procedures depends on the context of the situation, the appropriate troubleshooting function must be prepared.); and

b) supplying the inspection program to the customer (column 4: lines 14-17) (Instructing

the troubleshooting program to carry out specified troubleshooting operations in the digital

phone, is interpreted as supplying the inspection program to the customer.), wherein

an inspection result (results of troubleshooting) is generated by execution of the

inspection program on the electronic device on the customer's side, and diagnosis of the

electronic device is performed on the basis of the inspection result (column 3: lines 45-55,

column 4: line 59-64).

As in claim 27, Iglehart discloses an apparatus for diagnosing an electronic device

through computer communication, the electronic device belonging to a customer, the apparatus

comprising;

A receiving circuit for receiving an inspection result obtained by executing an inspection

program (results of troubleshooting) on the electronic device on the customer's side (column 4:

lines 62-64) (Some receiving mechanism, equivalent to a circuit must exist in the system in order

for the troubleshooting results to be received.); and

A processor for obtaining a diagnosis result by diagnosing the electronic device on the

basis of the inspection result (column 2: lines 3-19, column 3: lines 45-55, column 4: line 59-64).

As in claims 28 and 29, Iglehart discloses

The processor comparing a value included in the inspection result with a predetermined

threshold value, to thereby judge whether the electronic device needs repair or not (column 5:

lines 4-6). (Since the system is capable of determining which devices need repair, some sort of

threshold value that indicates when a device need repair and when a device does not need repair, must exist. For the system to determine where the inspection result falls in relation to the cutoff value, a diagnosis value must exist and a comparison must be made between this value and the cutoff value.)

As in claim 30, Iglehart discloses

Step a) including the step of confirming whether data received as an inspection result is a valid inspection result or not (column 4: line 59-column 5: line 2). (A second round of troubleshooting being necessary is interpreted as being the same as the inspection result not being valid, since this result will cause further troubleshooting.)

As in claim 31, Iglehart discloses the apparatus further comprising

A transmitting circuit for transmitting the diagnosis result toward the customer (column 5: lines 4-6). (Repair information is interpreted as being the same as the diagnosis result. In order for the system to send the repair information, the system must have some transmitting mechanism, equivalent to a circuit.)

As in claim 32, Iglehart discloses the apparatus further comprising

the processor accepting a request of repair from the customer (column 3: lines 4-16) (Since the repair is automatically performed, the initial malfunction cause the troubleshooting to occur, is interpreted as being the request of repair from the customer)

As in claim 34, Iglehart discloses the apparatus further comprising

the diagnostic result including information which indicates whether the electronic device

needs repair or not (column 5: lines 4-6). ("...necessary repairs, if any..." implies that some sort

of indication is included in the diagnosis result to distinguish between devices needing repair and

devices not needing repair.)

As in claim 35, Iglehart discloses the apparatus further comprising

The diagnostic result (performance characteristics) including information which indicates

a state selected from the group comprising:

A first state where the electronic device is normal;

A second state where the electronic device has trouble but needs no repair; and

A third state where the electronic device needs repair (column 2: lines 16-19 and column

5: lines 4-12). (Since the system diagnostic checkups on phones for which no malfunctions have

been reported, it is interpreted that normal state is included in the performance characteristics of

the phone. Also, since "...necessary repairs, if any..." implies that some sort of indication is

included in the diagnosis result to distinguish between malfunctioning devices needing repair and

malfunctioning devices not needing repair. Therefore, it is interpreted that the diagnostic results

include state information comprising normal, trouble but needs no repair and needs repair states.)

As in claim 37, Iglehart discloses a computer-readable medium carrying a program for

diagnosing an electronic device through computer communication, the electronic device

belonging to a customer (column 2: lines 9-12 and column 4: lines 14-21). (Instructing the

troubleshooting program to carry out specified troubleshooting operations in the digital phone is

interpreted as a program for diagnosing an electronic device. Transmitting signals that specify

the inspection program is interpreted as computer-readable medium carrying a program for

diagnosing an electronic device.), wherein execution of the program by a computer causes the

computer to perform a process comprising the steps of:

a) receiving an inspection result (results of troubleshooting) obtained by executing an

inspection program on the electronic device on the customer's side; and

b) obtaining a diagnosis result by diagnosing the electronic device on the basis of the

inspection result (column 2: lines 3-19, column 3: lines 45-55, column 4: line 59-64).

As in claim 38, Iglehart discloses a computer-readable medium being a hard disk system

connected to a server on a computer network (column 1: lines 6-9). (It is interpreted that all of

the data dictating the process of claim 37, is stored on the memory of the computer system.)

Claim Rejections - 35 USC § 103

7.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

8.   Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iglehart as

applied to claim 4 above, and further in view of Fawcett.

Regarding claims 5 and 6, Iglehart discloses the method of diagnosing an electronic device with an inspection program above. However, Iglehart does not specifically disclose registering the inspection program on a server connected to the computer network. Fawcett discloses a method of diagnosing an electronic device with inspection programs being registered on a server connected to the computer network in accordance with diagnostic items of the electronic device (column 2: lines 5-10, column 6: lines 35-45 and column 7: lines 36-40.) (The relevant diagnostic agent in interpreted as corresponding to the functions of the electronic devices.)

It would have been obvious to a person skilled in the art at the time the invention was made to register the inspection program on a server in the system taught by Iglehart. It would have been obvious because Fawcett teaches a system that saves product support center time, resources and money (column 2: lines 19-27). A person skilled in the art would understood that allowing new inspection programs to registered and downloaded to the electronic devices of Iglehart's system, would make the system more scalable and robust.

Conclusion

9.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

See PTO-892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anne L Damiano whose telephone number is (703) 305-8010. The examiner can normally be reached on M-F 9:00AM-6:30PM, first Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Beausoliel can be reached on (703) 305-9731. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Anne L Damiano
Examiner
Art Unit 2184

ALD
June 23, 2003

SCOTT BADERMAN
PRIMARY EXAMINER